

ESTTA Tracking number: **ESTTA29605**

Filing date: **04/01/2005**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following parties oppose registration of the indicated application.

Opposers Information

Name	The University of Iowa
Granted to Date of previous extension	04/02/2005
Address	120 Jessup Hall Iowa City, IA 52242-1316 UNITED STATES

Name	The Board of Regents, State of Iowa
Granted to Date of previous extension	04/02/2005
Address	120 Jessup Hall Iowa City, IA 52242-1316 UNITED STATES

Attorney information	Wendy K. Marsh McKee, Voorhees & Sease, PLC 801 Grand Avenue, Suite 3200 Des Moines, IA 50309-2721 UNITED STATES mvslit@ipmvs.com Phone:515-288-3667
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Applicant Information

Application No	76483437	Publication date	02/01/2005
Opposition Filing Date	04/01/2005	Opposition Period Ends	04/02/2005
Applicant	University of Southern Mississippi, The Post Office Box 5016 Hattiesburg, MS 39406 UNITED STATES		

Goods/Services Affected by Opposition

Class 006.

All goods and services in the class are opposed, namely: metal car tags, metal key chains, metal money clips, metal key rings and metal mailboxes

Class 009.

All goods and services in the class are opposed, namely: electric, luminous, neon and mechanical yard signs, telephones, magnets, radios hung on ropes, hockey, safety and bicycle helmets

Class 014.

All goods and services in the class are opposed, namely: clocks, precious metal money clips, watches, jewelry, namely class rings and ornamental lapel pins

Class 016.

All goods and services in the class are opposed, namely: bumper stickers, windows decals, paper car flags, bank checks, paper banners, paper pennants, greeting cards, post cards, graduation announcements, paper weights, stationery, binders, note books, and stationery-type portfolios

Class 018.

All goods and services in the class are opposed, namely: umbrellas, backpacks, wallets, brief-case type portfolios

Class 020.

All goods and services in the class are opposed, namely: pillows, diploma frames, picture frames, stadium seats, plastic banners, non-metal key chains, plastic car flags, non-metal money clips, non-metal mailboxes, plastic and non-metal key rings, plastic pennants and non-metal car tags

Class 021.

All goods and services in the class are opposed, namely: plastic beverage containers, mugs, glass beverage containers, ice buckets, salt and pepper shakers, birdhouses, pottery dinnerware, dinnerware including plates and cups, insulated sleeve holders for beverage

cans

Class 024.

All goods and services in the class are opposed, namely: afghans, towels, knit stadium blankets, cloth and felt pennants and cloth banners

Class 025.

All goods and services in the class are opposed, namely: T-shirts, polo shirts, sweaters, jerseys, wind suits, warm-up suits, rainwear, sleepwear, lingerie, neckwear, infant apparel, baseball caps, headwear, socks, gloves, ties, golf shoes and outerwear, namely, jackets, ponchos and overcoats

Class 027.

All goods and services in the class are opposed, namely: doormats

Class 028.

All goods and services in the class are opposed, namely: footballs, basketballs, christmas tree ornaments, plush toy mascots, balloons, beanbags and stuffed toys

Class 032.

All goods and services in the class are opposed, namely: bottled drinking water

Attachments	Statement of Claim.pdf (5 pages)
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Signature	/wendy k. marsh/
Name	Wendy K. Marsh
Date	04/01/2005

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<p>UNIVERSITY OF IOWA and THE BOARD OF REGENTS, STATE OF IOWA,</p> <p style="text-align:right">Opposer,</p> <p>v.</p> <p>UNIVERSITY OF SOUTHERN MISSISSIPPI,</p> <p style="text-align:right">Applicant.</p>	<p>Opposition No: _____</p> <p>In the matter of: Application No: 76/483,437 Mark: Published in Official Gazette on: February 1, 2005</p>
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STATEMENT OF CLAIM UPON WHICH OPPOSITION IS BASED

The grounds for opposition are as follows:

1. Opposer, The University of Iowa, has received registration upon the Principal Register, under the provisions of the U.S. Trademark Act of 1946, as amended, of trademarks including:

(1) BIRD HEAD design, Registration No. 2,616,009, September 3, 2002, for entertainment services, namely, presenting athletic events;

(2) BIRD HEAD design, Registration No. 1,772,928, May 25, 1993, for the following goods:

- International Class 14 - items of jewelry and wrist watches;
- International Class 16 - stationery and wrapping paper and checkbook holders.
- International Class 18 - wallets, attache cases, waist pouches, and all-purpose sports and athletic bags;

- International Class 20 - decorative novelty buttons and emblems.
- International Class 21 - beverage glassware;
- International Class 24 - flags and banners made of cloth and fabric;
- International Class 25 - wearing apparel; namely, aprons; infant wear; namely, bibs; bandannas and scarves; sport coats and vests; outerwear; namely, coats, jackets, parkas, gloves, mittens and scarves; shirts, jerseys and blouses; underwear; pajamas and robes; footwear including socks and athletic shoes; headwear; sweaters; neckwear; shorts; and sweatsuits, pants and shirts; and
- International Class 28 - sporting goods and toys; namely, basketballs; footballs; game boards and puzzles; golf clubs, bags and balls; toy stuffed animals and dolls; fishing lures; toy planes, trucks and cars; football helmets; toss toys; bowling pins; pool and cue balls; and toy banks.

(3) Registration No. 1,312,703; January 1, 1985, for entertainment services, namely, presenting athletic events at the university level.

These registrations were registered on dates prior to the date of filing of Applicant's application, and prior to any date of first use Applicant may claim. Said registered marks of Opposers' are valid and sustained and are prima facie evidence (conclusive evidence) of Opposers' exclusive right to use said marks in commerce on the goods and services specified in said registration.

2. Opposer, The Board of Regents, State of Iowa, is the governing body for Opposer, The University of Iowa, having statutory authority under Iowa Code Chapter 262.

3. Opposers have been for many years, and are now, using the BIRD HEAD designs depicted in U.S. Reg. Nos. 2,616,009, 1,772,928, and 1,312,703 in connection with the sale of the goods and services of these registrations in the United States, as well as in connection with the sale of a variety of other goods and services, including, but not limited to, the following:

- Wearing apparel; including T-shirts, sweatshirts, sandals, hats, polos, rubys, visors, sweat pants, ties, slippers, rainwear, sleepwear, lingerie, ponchos, wind suits, and oxfords;
- Sporting goods and toys; including baseballs, bats, golf balls, golf club grips, divot tools, golf tees, golf club headcovers, helmets, beanbags, and umbrellas;
- Collectibles, including Christmas tree ornaments, figurines, and lamps;
- Housewares, including signs, chairs, telephones, magnets, radios, ottomans, umbrella stands, night lights, mouse pads, picture frames, drapery panels, dust ruffles, stepping stones, sheets, pillow shams, afghans, doormats, clocks, mailboxes, and folding chairs;
- Posters and prints;
- Tailgating supplies, including spirit bands, fleece blankets, tables, temporary tattoos, fingernail accents, patches, can coolies, sports beads, picnic cups, napkins, lanyards, stadium seats, buttons, and windsocks;
- CDs, DVDs, and books;
- Pet accessories, including pet bowls, pet leashes, dog sweaters, and pet collars
- Bumper stickers, windows decals, paper car flags, bank checks, paper banners, paper pennants, greeting cards, post cards, graduation announcement, paper weights, stationery, binders, note books, and stationery-type portfolios; and
- Money clips, key chains, watches, and jewelry.

Said use has been valid and continuous since the date of first use and has not been abandoned.

Said marks of Opposers are symbolic of extensive goodwill and consumer recognition built up by Opposers through substantial amounts of time and effort in advertising and promotion, and are assets of Opposers.

4. Applicant has requested registration upon the Principal Register of the mark

BIRD HEAD Design for the following goods and services:

- International Class 6: Metal card tags, metal key chains, metal money clips, metal key rings and metal mail boxes;

- International Class 9: Electric, luminous, neon and mechanical yard signs, telephone, magnets, radios hung on ropes, hockey, safety and bicycle helmets;
- International Class 14: Clocks, precious metal money clips, watches, jewelry, namely class rings and ornamental lapel pins;
- International Class 16: Bumper stickers, windows decals, paper car flags, bank checks, paper banners, paper pennants, greeting cards, post cards, graduation announcement, paper weights, stationery, binders, note books, and stationery-type portfolios;
- International Class 18: umbrellas, backpacks, wallets, brief-case type portfolios;
- International Class 20: pillows, diploma frames, picture frames, stadium seats, plastic banners, non-metal key chains, plastic flags, non-metal money clips, non-metal mailboxes, plastic and non-metal key rings, plastic pennants and non-metal car tags;
- International Class 21: plastic beverage containers, mugs, glass beverage containers, ice buckets, salt and pepper shakers, birdhouses, pottery dinnerware, dinnerware including plates and cups, insulated sleeve holders for beverage cans;
- International Class 24: afghans, towels, knit stadium blankets, cloth and felt pennants and cloth banners;
- International Class 25: T-shirts, polo shirts, sweaters, jerseys, wind suits, warm-up suits, rainwear, sleepwear, lingerie, neckwear, infant apparel, baseball caps, headwear, socks, gloves, ties, golf shoes and outerwear, namely, jackets, ponchos and overcoats;
- International Class 27: doormats;
- International Class 28: footballs, basketballs, Christmas trees ornaments, plush toy mascots, balloons, beanbags and stuffed toys; and
- International Class 32: bottled drinking water.

5. Because of the nature of the respective goods and services of the parties and the similarity between their respective marks, Applicant's mark BIRD HEAD Design is likely to cause confusion, mistake, or deception with Opposers' previously used BIRD HEAD Design mark in the retail trade.

6. Registration of the mark shown in Application Serial No. 76/483,437 will result in damage to Opposers under the provisions of Section 2(d) of the U.S. Trademark Act, 15 U.S.C. § 1052(c), pursuant to the allegations stated above.

WHEREFORE, Opposers request that the registration sought by Applicant in Application Serial No. 76/483,437 be refused and that this opposition be sustained.